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REMARKS

Prior to the instant reply, claims 44-47 were pending in the present application. By this reply, claims 44 and 47 have been amended to correct typographical errors. No claims have been added or canceled. Accordingly, following the entry of this paper, claims 44-47 will be pending in the present application. Reconsideration and allowance of the application is respectfully requested in view of the above amendments and following remarks.

The 35 U.S.C. § 103 rejections

The Examiner has rejected claims 44-45 and 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,036,329 to Ando (hereinafter referred to as "Ando") in view of U.S. Patent No. 5,239,667 to Kanai (hereinafter referred to as "Kanai"). The applicant respectfully traverses the rejection.

Independent claim 44 is directed to a method of determining a Doppler search window for acquiring a satellite positioning system signal by a mobile communication device. The method comprises a combination of steps including, for example, determining a change in the received cellular communication signal resulting from motion of the mobile communication device; determining information representing the approximate motion of the mobile communication device according to the determined change in the received cellular communication signal; and determining the Doppler search window based on the information representing the approximate motion of the mobile communication device. It is submitted that the Examiner has not established *prima facie* obviousness.

It is well established that in order to establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success in the combination or modification. Third, the cited references must teach or suggest all claim limitations. Applicant respectfully submits that the Examiner has not established that there is any suggestion or motivation to modify and combine the references. Furthermore, the cited references, alone or in combination, fail to teach or suggest the

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combination of claim limitations as claimed in claim 44, and there is no motivation to modify the references in a manner that provides for the claimed invention. Further, because there is no suggestion or motivation to modify the references, and there is no teaching or suggestion for the combination of elements as claimed, the Examiner also has not demonstrated that there would be a reasonable expectation of success.

With respect to the cited references, Ando is directed to a vehicular mounted GPS receiver. In the event that the GPS receiver loses a satellite signal, as described at column 3 lines 7-10, the receiver attempts to regain the signal by searching for the signal at a search frequency within a range of a Doppler frequency shift that is predicted by a moving speed of a GPS receiver. Importantly, Ando is devoid of any mention of how the moving speed of the GPS receiver is determined. Ando simply assumes that the moving speed is available from the vehicle itself, and provides no discussion obtaining speed from another source. Furthermore, Ando is devoid of any mention of cellular or any wireless communication. In fact, Ando is completely silent on these points, and thus cannot provide any suggestion or motivation for obtaining motion information from any other source, or for any cellular communications.

Kanai is directed to controlling handoff between cell sites in a mobile communications system. Kanai discusses that Rayleigh fading can be affected by motion of the traveling terminal at column 3 line 63 through column 4 line 24. Kanai then goes on to describe how Rayleigh fading may be used to vary a threshold signal strength at which a handoff between cells is to occur, as discussed at col. 4 lines 31-53. Importantly, Kanai is devoid of any mention of positioning for a mobile terminal. Kanai is directed only to reducing the instances of premature cell handoff, and uses Rayleigh fading to adjust handoff threshold values based on signal strength. In fact, Kanai contains no mention of positioning at all, and thus cannot provide any suggestion or motivation for obtaining motion information for a mobile device.

As discussed, the cited references provide no suggestion or motivation to modify the references and/or combine the reference teachings. Furthermore, Applicant submits that the Examiner has not established that such suggestion or motivation can be found in the knowledge generally available to one of ordinary skill in the art. It appears that in the present case the only suggestion for the Examiner's combination of Ando and Kanai improperly stems from the

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Applicant's own disclosure and not from the cited references themselves. At best, the Examiner's comments regarding obviousness appear to amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the claimed invention because they would have had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. In brief, neither of the references alone or in combination provide any suggestion or motivation necessary to cause one skilled in the art to combine the references in the way the Examiner has done. Furthermore, the Examiner has not provided any reason that a skilled artisan, with no knowledge of the claimed invention, would have modified the cited references for combination in the manner claimed. It is also submitted that the cited references, alone or in combination, are devoid of any teaching or suggestion of the combination of elements as claimed.

Accordingly, it is submitted that claim 44 is allowable over the cited references. Furthermore, claims 45 and 47 each depend from claim 44, and are similarly allowable at least because these claims contains the elements of independent claim 44 from which they depend. These dependent claims may include one or more independent bases for patentability, and the right to assert any such basis in the future is reserved. Applicant therefore respectfully requests that the rejections of claims 44-45 and 47 be reconsidered and withdrawn.

The Examiner has rejected claim 46 under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Kanai, and further in view of U.S. Patent No. 5,859,612 to Gilhausen (hereinafter referred to as "Gilhausen"). The applicant respectfully traverses the rejection.

Claim 46 depends from previously discussed independent claim 44 and is similarly allowable at least because this claim contains the elements of independent claim 44. Furthermore, Gilhausen does not teach or suggest the method as claimed. Gilhausen is directed to a method for determining *position* of a mobile station within a cellular telephone system. Importantly, Gilhausen is devoid of any discussion of determining *movement* of a mobile station, and thus does not overcome any of the above-discussed deficiencies. Applicant therefore respectfully requests that the rejection of claim 46 be reconsidered and withdrawn.

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CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider the outstanding rejections and that these rejections be withdrawn. It is believed that a complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at the number provided.

Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case.

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: _____
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